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Application Number	10/005,196
Filing Date	December 4, 2001
First Named Inventor	Keith D. Allen
Group Art Unit	1632
Examiner Name	Valerie E. Bertoglio
Attorney Docket Number	R-632

Total Number of Pages in This Submission

9

ENCLOSURES (check all that apply)

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Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Nicole A. Verona, Reg. No. 47,153
Signature	<i>Nicole A. Verona</i>
Date	November 27, 2002

CERTIFICATE OF MAILING

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Keith D. Allen

Group Art Unit: 1632

Serial No.: 10/005,196

Examiner: Bertologio, Valerie E.

RECEIVED

Filed: December 4, 2001

Attorney Docket No.: R-632

DEC 05 2002

For: Transgenic Mice Containing FPR-RS4 Gene Disruptions

TECH CENTER 1600/2900

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed August 28, 2002 concerning the Examiner's restriction to the claims in connection with the above-referenced matter, Applicants provisionally elect with traverse, claims 6, 7, 9 and 14-21 classified by the Examiner as Group I drawn to a non-human transgenic animals and methods of making the animal.

In the restriction, the Examiner asserts that claims 1-34 are drawn to ten distinct subjects, grouped as: Invention I (claims 1 and 2), drawn to a targeting construct and a method of making said targeting construct; Invention II (claims 3-5, 8 and 22), drawn to genetically modified animal cell; Invention III (claims 6, 7, 9 and 14-21), drawn to a non-human transgenic animal and methods of making the animal; Invention IV (claims 10, 23, 29-32), drawn to methods of using a transgenic mouse with a disruption in the FPR-RS4 gene; Invention V (claims 11, 12 and 33), drawn to a method of identifying an agent by contacting the agent to a cell with a disruption in the FPR-RS4 gene; Invention VI (claims 13, 24 and 25), drawn to an agent that is an antagonist to FPR-RS4; Invention VII (claims 13, 24 and 25), drawn to an agent that is an agonist to FPR-RS4; Invention VIII (claim 26) drawn to an electronic database; Invention IX (claims 27-28), drawn to a method of treating anxiety; and Invention (X) (claim 34), drawn to a pharmaceutical composition. Applicants respectfully request reconsideration and withdrawal of the requirement.

Specifically, the Examiner asserts that the claims of Invention I and Invention II are unrelated because "the construct does not depend on the cells and the cells can be made without

the construct.” The Applicants disagree with the Examiner’s assertion that the claims of Invention I and II are unrelated. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention I and Invention III are patentably distinct because “the construct of Invention I does not have to be used to make the mouse of Invention III, nor does the mouse of Invention III require the construct of Invention I.” The Applicants disagree with the Examiner’s assertion that the claims of Invention I and III are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

It is also asserted by the Examiner that the claims of Invention I and Invention IV are unrelated because “the construct of Invention I is not needed for the methods of Invention IV and the method of Invention IV is not required for the construct.” The Applicants disagree with the Examiner’s assertion that the claims of Invention I and IV are unrelated. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention I and Invention V are patentably distinct because “Invention I can be used to express a protein while invention V can be used to identify an agent.” The Applicants disagree with the Examiner’s assertion that the claims of Invention I and V are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner further asserts that the claims of Invention I and Invention VI or VII are patentably distinct because “the construct group I can be used to transfect cells in vitro while inventions VI and VII ca be used to identify modulators of FPR-RS4.” The Applicants disagree with the Examiner’s assertion that the claims of Invention I and VI or VII are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner further asserts that the claims of Invention I, III-V and IX and Invention VIII are patentably distinct because “the methods of inventions I, III-V and IX do not require the databsase of invention VIII and the database does not require the methods.” The Applicants disagree with the Examiner’s assertion that the claims of Invention I, III-V and IX and Invention VIII are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention I and Invention IX are patentably distinct because "the construct is not needed for the method and the method is not needed for the construct." The Applicants disagree with the Examiner's assertion that the claims of Invention I and X are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention I and Invention X are patentably distinct because "the construct of invention I is not needed for invention X, nor is invention X needed for the construct." The Applicants disagree with the Examiner's assertion that the claims of Invention I and X are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention II and Invention III are related as product and process of use. It is asserted, by the Examiner, however, that the inventions are distinct because "the transgenic animals and methods of making the animals of invention III do not necessarily require the cells of invention II and the cells can be used for distinctly different processes." The Applicants disagree with the Examiner's assertion that the claims of Invention II and III are unrelated. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention II and Invention IV are patentably distinct because "the cells of invention II can be used to screen compounds while the method of invention IV can be used as a model of disease." The Applicants disagree with the Examiner's assertion that the claims of Invention II and IV are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention II and Invention V are related as product and process of use. It is asserted, by the Examiner, however, that the inventions are distinct, however, because "the process for using the product as claimed can be practiced with another materially different product or the product as claimed can be used in a materially different process of using that product." The Applicants disagree with the Examiner's assertion that the claims of Invention II and V are unrelated. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention II and Invention VI or VII are patentably distinct because "the cells are not necessary for the modulators and the modulators are not necessary for the cells." The Applicants disagree with the Examiner's assertion that the claims of Invention II and VI or VII are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention II and Invention VIII are patentably distinct because "the cells are not necessary for the database nor are [sic] the database necessary for the cells." The Applicants disagree with the Examiner's assertion that the claims of Invention II and III are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention II and Invention IX are patentably distinct because "the cells are not needed for the method and the method is not needed for the cells." The Applicants disagree with the Examiner's assertion that the claims of Invention II and IX are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Inventions II, III, VI or VII and Invention X are unrelated because "the transgenics of invention II and the FPR-RS4 modulators of inventions VI and VII are not necessary for the pharmaceutical composition of invention X and the pharmaceutical composition is not needed for the products of inventions II, III, VI and VII. The Applicants disagree with the Examiner's assertion that the claims of Inventions II, III, VI or VII and Invention X are unrelated. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention III and Invention IV are related as as product and process of use. It is asserted, by the Examiner, however, that the inventions are distinct because "agents can be identified using cells deficient of FPR-RS4 and the transgenic animals can be used for phenotypic analysis." The Applicants disagree with the Examiner's assertion that the claims of Invention III and IV are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention III and Invention V are patentably distinct because "transgenic animals are not needed for the methods of using the cells and the

methods are not needed for the transgenics.” The Applicants disagree with the Examiner’s assertion that the claims of Invention III and V are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention III and Inventions VI or VII are patentably distinct because “the transgenic animals are not needed for modulators and the modulators are not needed for the transgenics.” The Applicants disagree with the Examiner’s assertion that the claims of Invention III and Inventions VI or VII are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention III and Invention IX are patentably distinct because “the transgenics are not needed for the methods and the methods are not needed for the transgenics.” The Applicants disagree with the Examiner’s assertion that the claims of Invention II and IX are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention IV and Invention V are patentably distinct because “the methods are materially different” from each other. The Applicants disagree with the Examiner’s assertion that the claims of Invention IV and V are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention IV and Inventions VI or VII are patentably distinct because “the methods are not necessary to make the agent nor are the agents necessary for the methods.” The Applicants disagree with the Examiner’s assertion that the claims of Invention IV and Inventions VI or VII are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention IV and Invention IX are patentably distinct because the methods of each invention are materially different and plurally independent from each other because they are practiced with materially different process steps, technical considerations, and reagents.” The Applicants disagree with the Examiner’s assertion that the claims of Invention IV and IX are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention IV and Invention X are patentably distinct because the method of invention IV is not necessary for the pharmaceutical of invention

X and the pharmaceutical is not needed for the method.” The Applicants disagree with the Examiner’s assertion that the claims of Invention IV and X are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention V and Inventions VI or VII are patentably distinct because “the methods are not necessary to make the agent nor are the agents necessary for the methods.” The Applicants disagree with the Examiner’s assertion that the claims of Invention V and Inventions VI or VII are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention V and Invention IX are patentably distinct because “ the methods of invention V are not needed for those of invention IX and the methods of invention IX are not needed for invention V.” The Applicants disagree with the Examiner’s assertion that the claims of Invention V and IX are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention V and Invention X are patentably distinct because “the methods are not needed for the composition and the composition is not needed for the methods.” The Applicants disagree with the Examiner’s assertion that the claims of Invention V and X are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Inventions VI or VII and Invention VIII are patentably distinct because “the modulators of inventions VI or VII do not require the database of invention VIII and the database does not require the methods.” The Applicants disagree with the Examiner’s assertion that the claims of Inventions VI or VII and Invention VIII are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Inventions VI or VII and Invention IX are patentably distinct because “the agents are not needed for the method and the method is not needed for the agent.” The Applicants disagree with the Examiner’s assertion that the claims of Inventions VI or VII and Invention IX are patentably distinct. As such, a separate search or examination would not seriously burden the Examiner.

The Examiner also asserts that the claims of Invention IX and Invention X are related as product and process of use. It is asserted, by the Examiner, however, that the inventions may be

distinct because "the protein of invention X can be used to make antibodies and the process of treating disease of IX can be accomplished using materially distinct compounds." The Applicants disagree with the Examiner's assertion that the claims of Invention IX and X are unrelated. As such, a separate search or examination would not seriously burden the Examiner.

Although Applicant has provisionally elected Group I for purposes of advancing prosecution of the present application, Applicant contends, for the foregoing reasons, that the restriction requirement is improper. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the requirement.

A Petition for the Extension of Time for response to the Office Action for a period of one month from September 27, 2002 up to and including November 27, 2002 is submitted concurrently herewith.

Respectfully submitted,

Date: Nov. 27 2002

Nicole A. Verona
Nicole A. Verona (Reg. No. 47,153)

DELTAGEN, INC.
740 Bay Road
Redwood City, CA 94063
(650) 569-5100

CERTIFICATE OF MAILING

I certify that this document and enclosures are being deposited with the U. S. Postal Service with sufficient postage as first class mail in an envelope addressed to The Commissioner for Patents, Washington, D.C. 20231, BOX AMENDMENT November 27, 2002.

Deborah A. Mojarro
Deborah A. Mojarro